

REMARKS

Claims 1-22 were originally filed in the present application.

Claims 1-22 are pending in the present application.

Claims 1-22 were rejected in the September 20, 2007 Office Action.

No claims have been allowed.

No claims are amended herein.

Claims 1-22 remain in the present application.

Reconsideration of the claims is respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 103

The Examiner rejected Claims 1, 3-12 and 14-22 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0057657 to *La Porta, et al.* ("*La Porta*") in view of U. S. Patent Application Publication No. 2004/0005884 to *Nieminen, et al.* ("*Nieminen*") and Claims 2 and 13 under 35 U.S.C. §103(a) as being unpatentable over *La Porta* in view of *Nieminen* and further in view of U.S. Patent Application No. 6,999,766 to *Padovani* ("*Padovani*"). Of these, Claims 1 and 12 are independent. These rejections are respectfully traversed for the reasons discussed below.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).) The initial burden of establishing a *prima facie* basis to

deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984).) Only when a *prima facie* case of obviousness is established does the burden shift to the Applicant to produce evidence of non-obviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993).) If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).)

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must not be based on the Applicant's disclosure. (*MPEP* § 2142).

In order to establish obviousness by combining references there must be some teaching or suggestion in the prior art to combine the references. (*Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 U.S.P.Q.2d 1294, 1297 (Fed. Cir. 1997) ("It is insufficient to establish obviousness that the separate elements of an invention existed in the prior art, absent some teaching

or suggestion, in the prior art, to combine the references.”); *In re Rouffet*, 149 F.3d 1350, 1355-56, 47 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1998) (“When a rejection depends on a combination of prior art references, there must be some teaching, or motivation to combine the references.”).)

Evidence of a motivation to combine prior art references must be clear and particular if the trap of “hindsight” is to be avoided. (*In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999) (Evidence of a suggestion, teaching or motivation to combine prior art references must be “clear and particular.” “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’”); *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998) (“[R]ejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be ‘an illogical and inappropriate process by which to determine patentability.’”).)

The Applicant respectfully submits that neither *La Porta* nor *Nieminen*, either alone or in combination, discloses, teaches or suggests “a local Internet protocol (IP) network capable of transferring data packets associated with said MS-MS packet data call directly between said first and second base stations via a first packet data bearer connection, wherein said first base station is capable of receiving a first message from said source mobile station indicating that said source mobile station is to be handed off to a third base station, and wherein said first base station, in response to said first message, initiates establishment of a second packet data bearer connection on

said local IP network for transferring said data packets associated with said MS-MS packet data call directly between said second and third base stations,” as recited by independent Claim 1.

The Examiner has cited no reference to any teaching of an MS-MS packet data call in which data packets are transferred directly between first and second base stations. In fact, the component of *La Porta* cited by the Examiner to show the claimed second base station is a correspondent node that may communicate with a base station through (i) a service provider, (ii) the Internet, (iii) a root router, and (iv) a downstream router. See, *La Porta*, Figure 2. Thus, as the data to and from the correspondent node would be processed through at least these four components, *La Porta* fails to disclose teach or suggest a network transferring data packets directly between the cited base station and the cited correspondent node.

In contrast, independent Claim 1 recites a local IP network “capable of transferring data packets associated with said MS-MS packet data call directly between said first and second base stations via a first packet data bearer connection” and “said first base station, in response to said first message, initiates establishment of a second packet data bearer connection on said local IP network for transferring said data packets associated with said MS-MS packet data call directly between said second and third base stations.” By routing the data directly between base stations without additional routing to other components such as a PSDN, for example, the claimed local IP network provides for MS-MS “packet data connections that have low delay and low jitter characteristics.” Present Application, para. 8. The system of *La Porta*, on the other hand, routes data through several additional components and, thus, does not provide this benefit of the claimed invention. Therefore,

for at least this reason, a *prima facie* case of obviousness against independent Claim 1 has not been presented with reference to the cited art, either alone or in combination. Therefore, the Applicant respectfully submits that this rejection should now be withdrawn.

Similar to independent Claim 1, independent Claim 12 recites “in response to the first message, initiating establishment of a second packet data bearer connection on the local IP network for transferring the data packets associated with the MS-MS packet data call directly between the second and third base stations.” Accordingly, for the reasons discussed above in connection with Claim 1, independent Claim 12 is not made obvious by the cited art. Therefore, the Applicant respectfully submits that this rejection should now be withdrawn.

Dependent Claims 2-11, which depend from independent Claim 1, and dependent Claims 13-22, which depend from independent Claim 12, are also not made obvious by the cited art because they include the limitations of their respective base claims and add additional elements that further distinguish the art. Therefore, the Applicant respectfully submits that these rejections should now be withdrawn.

The Applicant also disagrees with the Examiner’s rejections of Claims 1-22 based on additional misdescriptions and/or misapplications of *La Porta*, *Nieminen* and *Padovani* to at least some of Claims 1-22. However, the Applicant’s arguments regarding those other shortcomings of *La Porta*, *Nieminen* and *Padovani* are moot in view of the Claim 1 arguments above. However, the Applicant reserves the right to dispute in future Office Action responses the appropriateness and the

applications of *La Porta*, *Nieminen* and *Padovani* to the claims of the present application, including the right to dispute assertions made by the Examiner in the September 20, 2007 Office Action.

SUMMARY

For the reasons given above, the Applicant respectfully requests reconsideration and allowance of the pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@munckbutrus.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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